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EXAMINER

JANVIER, JEAN D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,775

Applicant(s)

LI, WEIJUN

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/31/06 has been entered.

Response To Applicant's Amendments

First, during a "courtesy after final chat" granted to the Applicant on January 17, 2006, the Examiner came to agree with the Applicant that the prior art or Fuller's Patent does not immediately teach separating the advertisement from the electronic document or software (said electronic content being provided separately from said at least one electronic advertisement).

Further, the step of separating the advertisement from the electronic document or software (said electronic content being provided separately from said at least one electronic advertisement) is interpreted as --redirecting, in response to a user's request for the electronic content, the system or executable module to a server where the at least one advertisement is retrieved if the user's right to the electronic content is restricted-- in accordance with paragraphs [0027] and [0028] of the specification.

Finally, the Examiner approves the new title of the invention.

DETAILED ACTION

Specification

Status of the claims

Claims 1-35 are pending in the Instant Application. Claims 1-29 are elected, without traverse, for prosecution on the merits. Hence, claims 30-35 are withdrawn from further consideration. Applicant should cancel the withdrawn claims in a future correspondence.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuller et al. (hereinafter Fuller), US Patent 6, 216, 112 B1.

As per claims 1-29, Fuller discloses a method and system for distributing free software, having advertisements embedded therein, to customers and compensating the authors of the software for every copy of the software illegally distributed by collecting payments from advertisers or sponsors whose advertising messages are inserted in the said software to be displayed on the customer's or user's PC screen. The software or application software,

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downloaded over the Internet from a web site related to a computer server 102 of fig. 1 or shipped to a user on a floppy disk or a CD ROM (Media player) to be installed on the user's PC 110 of fig. 1, is executed by the user on his PC 110 of fig. 1 subsequent to installing the software on his computer hard disk (See abstract; col. 2: 30-32). **Here, the user has restricted rights to the free software and thus, he must occasionally or periodically read advertising messages whenever he executes the said software or before using the software.**

Furthermore, application software usage by the user or the number of times (the length of time) the user has executed the application software or software is stored in a local database or data file of the user's computer 110 and periodically transmitted by said application software to a remote device or remote server or the computer server 102 of fig.1, wherein this transmitting step is performed by a local browser plug-in running on the user's PC 110 whenever the user logs into the Internet and wherein this usage information is used **to update** or refresh the application software or advertisements using a hook originally encoded within the application software and/or to properly compensate developers or authors of the application software. It is to be understood that users' accounts, software developers' or authors' accounts, advertisers' accounts including advertisers' billing records and compensations or fees, that must be paid to software developers or authors, are recorded or stored in databases associated with the computer server or rewards computer 102 of fig.1 (See abstract; col. 2: 39-43; col. 2: 50-67; col. 3: 46-56; col. 5: 1-4; col. 19: 9-17; col. 19: 55-65; figs. 1-5).

Moreover, under the restricted model, the user is not only required to read the advertisements embedded in the Software before he uses it, but also he may be required to interact with the displayed or played advertisements by providing answers to a survey, clicking

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on URLs or hyperlinks, displayed in the interface of the Software or advertisement, to visit associated vendors' web sites to receive more information about advertised products or services or even purchase the advertised products/services featured in the advertisements or the Software itself. The interaction with the one or more displayed ads may be optional (one or more advertisements or a sequence or plurality of advertisements are played or displayed during the use of the Software or until the user pays for the Software or the advertisements expire). See Col. 3: 58-62; col. 14: 62-64; **col. 15: 9-53**; col. 15: 54 to col. 16: 16; col. 13: 58 to col. 14: 16; fig. 3. In another embodiment, under the unrestricted model, the user decides to purchase or pay for the free download or free Software or Adware program. In this case, the advertisements embedded in the Software to be first displayed **or played** before the user is allowed to use the Software are disabled. In other words, the user receives the electronic content without advertisements (col. 17: 40 to col. 18: 37)

In all embodiments, the free Software is downloaded from server 102 to the user's computer 110, wherein established protocols and error correction and security techniques (**encryption technology**) are used to securely transmit the Software to the user's computer (col. 8: 10-19). Moreover, the software or application software, stored in the user's PC local database or data file after the download, is encrypted in order to prevent the user from altering the Software and disabling the advertising program embedded in the software and scheduled to run on the user's computing device whenever the user executes the said software (as long the user does not pay for the software as described in the restricted model) (col. 4: 16-24; col. 10: 8-43; col. 18: 27-37).

Alternatively, instead of providing software programs, the server 102 can make data available to computer users. The data can take many forms including graphic, audio, video data. For example, the data could be a digitized cartoon or video clip or financial research data compiled by a securities firm (col. 8: 4-9).

See in general col. 2: 50 to col. 5: 19; col. 8: 43 to col. 9: 22; col. 10: 8-43; col. 14: 56 to col. 15: 8; col. 18: 6-37; col. 6: 41-57; see also claims 12 and 15 of the current reference.

As per claims 1 and 16, Fuller does not expressly disclose loading the advertisement content separately from the software content, by retrieving the advertisement content from a different or remote database or server, when it is determined that the user, requesting access to the software, does not purchase the software (separately providing the electronic content from the advertisement content if the user's right to the electronic content is restricted).

However, it is common practice in the art to redirect a user's browser to a third party web site, having a web server, to view advertising content when the user visits a host site to request access to a primary electronic content, wherein the advertisement content is retrieved from the third's party web site, while the primary content is separately provided by the host web site. In some instances, the user is compensated for viewing the advertisement or free access is provided to the primary content or service if a fee is required in exchange for reading or viewing the advertisement. It also customary in the art for a user to request access to a paid content or service, wherein the user can either pay to access the content or the user may agree to first read advertisement from an advertiser before giving access to or receiving the paid content or service.

“Official Notice”

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure (“Official Notice”) into the Fuller’s system so as to independently or separately load the advertisement content on a database or remote computer or server (central computer) and insert into the software or electronic content by the software developer or programmer (author) a hook (executable module) configured to retrieve from the database or remote server, over a communication link, an appropriate advertisement, which is displayed to the user before accessing or receiving the requested electronic content or software when it is determined that the user does not purchase the said requested electronic content or software (the user having a restricted right to the software) and the user has agreed to view or read at least one advertisement from an advertiser in return or in exchange for receiving the software or electronic content for free, thereby enabling the system to present at all times updated advertisement content to the user in real-time since the advertisement content or advertising data are centrally stored on a database or remote server separate from the user’s computer, while freeing critical resources or memory space on the user’s computer, as one of ordinary skills in the art of computer technology would have understood at the time of the invention.

Response To Applicant’s Arguments

Applicant’s arguments with respect to amended independent claims 1 and 16 have been considered but are moot in view of the new ground(s) of rejection. In other words, Applicant’s remarks are addressed in the above action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 6,771,290 to Hoyle discloses a method and apparatus for providing an automatically upgradeable software application including targeted advertising based upon demographics and user interaction with the computer. The software application includes a display region used for banner advertising that is downloaded over a network such as the Internet. The software application is accessible from a server via the network and demographic information on the user is acquired by the server and used for determining what advertising will be sent to the user. The software application further targets the advertisements in response to normal user interaction with the computer. Data associated with each advertisement is used by the software application in determining when a particular advertisement is to be displayed. This includes the specification of certain programs that the user may have so that, when the user runs the program (e.g., a spreadsheet program), a relevant advertisement will be displayed (e.g., an advertisement for a stock brokerage). This provides two-tiered, real-time targeting of advertising--both demographically and reactively. The software application includes programming that accesses the server to determine if one or more components of the application need upgrading. If so, the components can be downloaded and installed without further action by the user. A distribution tool is provided for software distribution and upgrading over the network. Also provided is a user profile that is accessible to any computer on the network. Furthermore, multiple users of the

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same computer can possess Internet web resources and files that are personalized, maintained and organized (see abstract).

WO 99/52056 to Horstmann provides a mechanism for allowing a software developer to present advertisements through a software program. In accordance with an exemplary embodiment of the invention, an advertisement module is attached to the software program. The function of the advertisement module is to retrieve advertisements from an advertisement server and to display them to the user. The advertisements are varied to retain the interest of the user. Furthermore, information about the user may be sent to the advertisement server, allowing advertisements to be targeted to the user. Such information may include the category of the software program and the user's usage of the software program, for example. Associated with the ad server are a rules engine and a usage database. Various policies may be controlled by the software developer as well as the operator of the ad server, including the nature of information to be sent to the advertisement server, whether connection will be scheduled or will occur "opportunistically" in conjunction with user-initiated Internet access, whether prolonged inability to connect will result in use of the software being disallowed, etc. When the user clicks on the ad being displayed, the ad module may cause various actions to be taken. For example, a Web browser on the user's machine may be started up and pointed to a location providing further information about the subject matter of the ad. Alternatively, the ad module may simply show a new ad in the ad screen. The new ad could be a repeat of an already downloaded ad (with repeat count and frequency specified by instructions accompanying the ad) or it could be a freshly downloaded ad. The usage database associated with the ad server is used to compute billing to

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advertisers, provide for auditing of circulation, etc. Click-through rewards may be provided for in which the software publisher is paid each time a user expresses interest in an ad carried by a software program of the software publisher by clicking through the ad (see the summary section).

USP 5, 774,869 to Toader discloses a method for promoting a sponsor's products by providing a consumer or potential consumer with sponsor-paid access to the Internet includes the step of distributing a floppy disc with Internet access software thereon. Associated with the floppy disc is a unique PIN number along with instructions on installing and using the Internet access software on a personal computer (PC). The Internet access software accesses and "handshakes" with an "Internet Entry Server", which verifies the PIN number, provides the access and times the sponsor paid Internet access time. In return, the Internet Entry Server performs as registration process which includes a number of personal questions and custom data gathering queries tailored by the sponsor for response by the user and initially gives the user a mandatory "guided tour" of the sponsor's Internet Home Page and domain where the user is exposed to current products and/or services of the sponsor and can download promotional coupons, product information, etc. The user is then released to browse the Internet and, after the free time is over, user paid refresh options are provided (see abstract).

USP 5,964,660 to James discloses, in one embodiment, a computer game that is played over a computer network and is capable of accommodating a large number of players. When the game is play on the Internet, players are able to input moves and be apprised of the state of the

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game using the basic input/output functions of their Web browser. Consequently, the game can be played with substantially no other game related software, plug-ins or add-ons. Another embodiment of the invention relates to the management of a game database so as to compensate for the lack of game resources that a newer player has relative to older players that are likely to possess significantly greater game resources. Further, the virtual space of the game is highly expandable and updatable. In another embodiment of the invention a game is provided that couples game playing and advertising via a game currency that an advertiser can provide to a player and which can be used by the player in playing the game. In general, the player visits an advertiser's site to read advertisements in exchange for play money or play currency that the player uses to play the game or to access the game content (see abstract; col. 5: 9-64).

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

JDJ
03/16/06**JEAN D. JANVIER
PRIMARY EXAMINER**
